

#18/RESPONSE
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Mallik AF/2800



REPLY UNDER 37 C.F.R. § 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 2816

5500-36101/TT2823CPA

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Gardner et al.

Serial No. 09/207,972

Filed: December 9, 1998

For: ULTRATHIN HIGH-K GATE
DIELECTRIC WITH FAVORABLE
INTERFACE PROPERTIES FOR
IMPROVED SEMICONDUCTOR
DEVICE PERFORMANCE



Group Art Unit: 2815
Examiner: Warren, M.

Atty. Dkt. No. 5500-36101



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on the date indicated below:

January 16, 2003
Date

Robert C. Kowert

AMENDMENT; RESPONSE TO FINAL ACTION MAILED NOVEMBER 19, 2002

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This paper is submitted in response to the Final Action mailed November 19, 2002 to further highlight reasons why the application is in condition for allowance.

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REMARKS

Claims 16-33 are pending in the case. Reconsideration of the presently claimed application is respectfully requested.

Request to Withdraw Finality of the Rejection:

In the previous Office Action, claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,596,214 to Endo in view of Kizilyalli and Wu. However, in the

present Action, claim 20 is rejected as being unpatentable over Kizilyalli in view of Wu as applied to claim 16, and further in view of U.S. Patent No. 5,994,734 to Chou. Applicants' previous response did note the ambiguous nature of this rejection in that the rejection was made based on Endo but described in terms of Chou. Nevertheless, the rejection was formally stated in the previous Action as relying on Endo with Endo as the primary reference. The rejection is stated in the present action as relying on Chou with Chou as a secondary reference. The confusion regarding this rejection was clarified by the Examiner for the first time in the present Action. The rejection has been stated differently in the present Action, thus it constitutes a new ground of rejection. Since this new ground of rejection was not necessitated by an amendment, it is improper for the present Action to be made a Final Action. *See* M.P.E.P. § 706.07(a). Thus, Applicants request withdrawal of the finality of the present Action.

Section 103 Rejections:

Claims 16-19, 21, 23, 30 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,320,238 to Kizilyalli et al. (hereinafter "Kizilyalli") in view of U.S. Patent No. 5,880,508 to Wu (hereinafter "Wu"). Claim 20 was newly rejected under 35 U.S.C. § 103(a) as being unpatentable over Kizilyalli in view of Wu as applied to claim 16, and further in view of U.S. Patent No. 5,994,734 to Chou (hereinafter "Chou"). Applicants respectfully traverse these rejections in light of the following remarks.

The Examiner has not shown that the relied-upon subject matter of the Kizilyalli patent qualifies as prior art. Kizilyalli was filed on June 25, 1999 and is a continuation-in-part of application No. 08/995,435, filed on December 22, 1997. Since the filing date of the Kizilyalli patent is after the filing date of the present application, only the material that is common to both the Kizilyalli patent and its parent would be eligible as potential prior art. *In re Wertheim*, 209 USPQ 554 (CCPA 1981). The Examiner did not show that the portions of the Kizilyalli patent on which the rejections are based were also present in the Kizilyalli patent's parent application. Therefore, the Examiner has not established that the material relied on in Kizilyalli to reject Applicants' claims is actually prior art to Applicants' application. Note also that the filing date of the Kizilyalli patent's parent can only be used as the prior art date if the parent supports the claims of the child continuation-in-part reference (the claims of the Kizilyalli patent). *See* M.P.E.P. § 2136.03(IV). Since the Examiner has not shown that the claims of the Kizilyalli patent are supported in its parent application, the Examiner has not shown that Kizilyalli qualifies as prior art. The burden of proof falls on the Examiner to show that Applicants' claims are unpatentable over the prior art. *In re Warner*, 154 USPQ 173, 177 (C.C.P.A. 1967), *cert. denied*, 389 U.S.

1057 (1968). Since the Examiner has not shown that the portions of the Kizilyalli patent on which the rejections are based qualify as prior art, the Examiner has not met his burden of proof.

Allowable Subject Matter:

Claim 22 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. In light of the above remarks, Applicants assert that claim 22 is allowable in its present form.

Claims 24-29, 32, and 33 are allowed.

CONCLUSION

In the present response, Applicants have responded to the objection to claim 22 and the rejections of claims 16-21, 23, 30 and 31. Accordingly, Applicants submit that this response constitutes a complete response to all issues raised in the Office Action mailed November 19, 2002. In view of the remarks traversing the rejections, Applicants assert that pending claims 16-33 are in condition for allowance. If the Examiner has any questions, comments or suggestions, the undersigned earnestly requests a telephone conference.

No fees are should be required for filing this response; however, the Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-1505/5500-36101/RCK.

Also, enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Change of Address

Respectfully submitted,



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Date: January 16, 2003